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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/388,726	09/02/1999	DR. HOWARD AN	OSTEONICS3.0	4364

530 7590 04/09/2002

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EXAMINER

PELLEGRINO, BRIAN E

ART UNIT PAPER NUMBER

3738

DATE MAILED: 04/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/388,726

Applicant(s)
An et al.

Examiner
Brian Pellegrino

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3738



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 16, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above, claim(s) 16, 17, and 34-40 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27-33 is/are allowed.
- 6) ☒ Claim(s) 1-15 and 18-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 15
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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DETAILED ACTION

Request for Continued Examination

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/16/01 has been entered.

Election/Restriction

2. Claims 16 and 17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 10. Applicants acknowledged the election of Species I in Paper No. 11.

Claim Rejections - 35 U.S.C. § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 5, 11, 19-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 5, 11, it is not clear if the first member has an additional component because the claims recite "comprising a hollow member" and claims 19-26 recite an "outer tubular member" respectively. This would imply there are two concentric tubes for just the first member.

With respect to claim 20, it is not clear if the locking clip is intended to have four surfaces because in line 14, it recites "third surface portion and fourth surface portion", but the claim fails to recite what has first and second surface portion.

Claim Rejections - 35 U.S.C. § 102

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1, 3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Sagar (5702455). It can be seen (Fig. 1) that the spinal fusion device contains a first member 1 moveable with respect to second member 2. It can be seen the first member has a hollow tubular body and a "locking clip 4" rotatably mounted thereto. It can be construed that the adjustable member 4 can be locked in a locked position when second member 2 engages or is screwed to meet the adjustable member, since both would not be able to move any further. It can be seen

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that both the "locking clip" and second member include interengaging threads to mate with threads on first member.

7. Claims 1-9, 13-15, 18, 26 are rejected under 35 U.S.C. 102(a) as being anticipated by Schar et al. (WO 98/46173). Fig. 3 teaches a vertebral implant having a first hollow member 2 with a flange 39 having teeth 40. It can also be seen that the first member telescopingly receives second member 1 also having an outwardly extending flange 38 with teeth 40. Fig. 5 teaches the locking clip 13 includes at least one depression 22 and a second member has a "ridge" 21 engageable in the depression to lock the elements in a relative position. Fig. 4 teaches a locking clip 13 and second member 1 include interengaging threads for locking the elements in a particular position, see Fig. 3. The clip contains a gap that can be construed as a bore that is engaged by a screw 35 shown in Fig. 3. See US 6176881 for translation if needed.

Claim Rejections - 35 U.S.C. § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schar et al. (WO 98/46173) in view of Studer et al. (6193756). Schar et al. is explained supra. However, Schar does not disclose perforations in the first member. Studer teaches to use elongated

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perforations on one member and "substantially" circular on the other for bone material, col. 2, lines 64,65. The term "substantially" is a broad term and does not provide and limits as to what is really intended to be the scope of the limitation. Thus, it would have been obvious to one of ordinary skill in the art to use the perforations of Studer in the vertebral prosthesis of Schar in order to enable the device to properly stabilize in the spine.

10. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schar et al. (WO 98/46173) in view of Wu (4553273). Schar is explained above. However, Schar does not disclose an outer surface different than the inner surface of the components. Wu teaches that moveable components that operate with respect to one another along a longitudinal axis have surfaces that are preferably polygonal for gripping. It would have been obvious to one of ordinary skill in the art to use the teaching of Wu to provide polygonal shaping on the outer surface of the prosthesis of Schar in order to enable the surgeon to have a secure grip that enables proper placement in the patient.

Response to Arguments

11. Applicant's arguments filed 8/16/01 have been fully considered but they are not persuasive. In response to Applicant's argument that the Schar locking ring operates differently and does not include the feature of Applicant's invention, the limitations on which Applicant relies (clip does not engage the inner member) are not stated in the claims. It is the claims that define the claimed invention, and it is the claims, not specifications that are anticipated or unpatentable. *Constant v. Advanced Micro-Devices Inc.* 7 USPQ2d 1064.

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Regarding the Saggar reference, it should be noted that the "locking clip" is element 4 and is unlocked when not against the first member 2 and locked when against it since both would not be able to be threaded further.

Allowable Subject Matter

12. Claims 27-33 are allowed.
13. Claim 19 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Pellegrino whose telephone number is (703) 306-5899. The examiner can normally be reached on Monday-Thursday from 8am to 5:30pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-2708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Brian E. Pellegrino

Bruce Snow

TC 3700, AU 3738

Primary Examiner

